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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,010	12/15/2005	Volker Stanjek	WAS0749PUSA	1206

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EXAMINER	
GILLESPIE, BENJAMIN	

ART UNIT	PAPER NUMBER
1711	

MAIL DATE	DELIVERY MODE
08/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/595,010	STANJEK ET AL.	
	Examiner	Art Unit	
	Benjamin J. Gillespie	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/13/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 12-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Firstly the language "at least one low molecular weight diol (A2) having at least two hydroxyl groups" renders the claims indefinite because diols have only two hydroxyl groups, however based on the claim language compound (A2) may have three or more hydroxyl groups, clarification is required. Secondly the language "substantially" render claims 25 and 28 indefinite because it is a relative term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12-22, 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller et al ('290). Muller et al disclose a room-temperature moisture curable composition that is the reaction product of diisocyanate, polyol, and alkoxysilylmonoamines, wherein the final composition contains no free NCO groups (Col 1 lines 21-23; col 5 lines 40-42). In particular, patentees teach the diisocyanate consists of isophorone diisocyanate (IPDI), the polyol is a mixture of high molecular weight polyether polyol and low molecular weight dihydric alcohols, such as butanediol, ethylene glycol, propylene glycol, and propanediol, and the

alkoxysilylmonoamines share the same structure as the compounds in claims 12, 14, 18, and 26 (Col 2 lines 41-64; col 3 lines 9-27, 54-63).

3. Regarding the claimed amounts of high and low molecular weight polyol, Muller et al explain that per 1 part of polyether polyol, 0-0.6 parts by weight of dihydric alcohol can exist depending on the desired properties of the final composition. Therefore based on this disclosure and the breadth of applicants' claimed range as well as the possible molecular weights for said polyether, the claimed molar range is satisfied (Col 2 lines 65-68; col 3 lines 1-4). Finally, patentees disclose that the composition may optionally contain additives such as silica (Col 4 lines 30-37; col 5 lines 54-55).

4. Claims 12-28 are rejected under 35 U.S.C. 102(b) as being anticipated by (WO 00/35981) translation provided by Majolo et al ('903). Majolo et al teach a room-temperature moisture curable composition that is the reaction product of diisocyanate, high and low molecular weight polyol, and alkoxysilanes, wherein the final composition contains no free NCO groups (Col 1 lines 26-28; col 2 lines 64-67; col 3 lines 1-10, 24-26; col 18 line 13). In particular, patentees teach the diisocyanate consists of isophorone diisocyanate (IPDI) diphenylmethane diisocyanate (MDI) and toluene diisocyanate (TDI), the high molecular weight polyol is based on polyether, polyester, and/or polycarbonate, the low molecular weight polyol consists of butanediol, ethylene glycol, propylene glycol, and propanediol, and finally the alkoxysilanes share the same structure as the compounds in claims 12, 14, 18, 23, and 26 (Col 3 lines 1-32, 42-47, 59-67; col 4 lines 59-62; col 6 lines 25-30).

5. Regarding the claimed molar ratio of claims 12 and 27, patentees explain that up to 20% by weight of low molecular weight polyol can be present and therefore based on the breadth of

applicants' claimed range as well as the possible molecular weights for said high molecular weight polyol, the claimed molar range is satisfied (Col 2 lines 65-68; col 3 lines 1-4). Finally, patentees disclose that the composition may optionally contain solvent and additives such as silica (Col 7 lines 18-20; col 16 lines 28-34).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muller et al ('290) in view of (WO 00/35981) translation provided by Majolo et al ('903). Aforementioned, Muller et al teach a room-temperature moisture curable composition that is the reaction product of diisocyanate, polyol, and alkoxysilanes, however Muller at al only disclose amine functional silanes and fails to teach compounds corresponding to claim 23. Majolo et al also teach room temperature moisture curable compositions comprising the reaction product of diisocyanate,

polyol, and alkoxysilanes, and in particular patentees explain that the isocyanate reactive alkoxysilanes can not only consist of amine based compounds but also hydroxyl functional compounds.

8. Therefore it would have been obvious to one or ordinary skill in the art to substitute the isocyanate-reactive silane compound of Muller et al for the hydroxyl-functional silane of Majolo et al based on the motivation that the mere substitution of an equivalent (something of equal in value or meaning, as taught by analogous prior art) is not an act of invention; where equivalency is known to the prior art, the substitution of one equivalent for another is not patentable, i.e. it would have been obvious. *In re Ruff* 118 USPQ 343 (CCPA 1958).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin J. Gillespie whose telephone number is 571-272-2472. The examiner can normally be reached on 8am-5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B. Gillespie

RABON SERGENT
PRIMARY EXAMINER